REMARKS

Claims 1, 2 and 4 - 10 remain in this patent application, claim 1, claim 3 having been canceled without prejudice or disclaimer.

Claims 1 and 6 - 10 have been amended in order to more particularly point out, and distinctly claim the subject matter to which the applicants regard as their invention. It is believed that this Amendment is fully responsive to the Office Action dated January 11, 2007.

Claim 7 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The applicants respectfully request reconsideration of this rejection.

In July 1998, the Federal Circuit, in the case of *State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998) settled all confusion by suggesting that almost any unobvious software-related invention is patentable if the claims are properly drawn. The patent involved in *State Street Bank*, U.S. Patent No. 5,193,056, is generally directed to a data processing system for implementing an investment structure dealing with the administration and accounting of mutual stock funds.

In explaining its decision, the Federal Circuit cited its previous holding in *Arrhythmia Research Technology, Inc. v. Corazonix Corp.*, 22 USPQ2d 1033 (Fed. Cir. 1992) that:

> the *transformation* of electrocardiograph signals from a patient's heartbeat by a machine *through a series of mathematical calculations* constituted a practical application of an abstract idea (a mathematical algorithm, formula, or calculation), because it corresponded to a *useful, concrete or tangible thing*-the condition of a patient's heart. (*State Street* at 1601; emphasis added).

From this "transformation of data" concept, the transformation necessary in the invention, i.e., "a useful, concrete and tangible result," *no* longer needed to be physical in order to be patentable subject matter. Instead, the Federal Circuit held that the transformation of data in a software-related patent, *e.g.*, in the *State Street Bank* case, which represented "discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price," constitutes:

(a) a "practical application of a mathematical algorithm, formula, or calculation", but

(b) nevertheless, produces "a useful, concrete and tangible result."

In the *State Street Bank* case, the "useful, concrete and tangible result" is the information subsequently relied upon by regulatory authorities and for trading purposes. Items (a) and (b), above, are thus the necessary tests for determining patentable subject matter for claims dealing with software.

In the case at issue, the "useful, concrete and tangible result" of the claimed invention, as set forth in claim 7, is in the initial determination whether the recording medium has a wobble or not only if it is determined that key-bunch information is recorded; and then, an operation of reproduction from the recording medium is restricted if the recording medium is determined as having a wobble.

In view of the above, the withdrawal of the outstanding rejection under 35 U.S.C. §101 is in order, and is therefore respectfully solicited.

Further, the following rejections are set forth in the outstanding Action:

(1) claims 1 - 4 and 6 - 10 stand rejected under 35 U.S.C. §102(b) as being anticipated by Tosaki (EP 1 067 544 A1); and

(2) claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Tosaki in view of "Applicant's Admitted Prior Art" (AAPA).

The applicants respectfully request reconsideration of these rejections.

The applicants' claimed invention, as now recited in the amended claims filed herewith, are directed to a claimed device or claimed program that undergo a step for determining the presence of wobble only when it is determined that key-bunch information is recorded, which reduces time

required for reproducing process as compared to an arrangement that the presence of wobble is always judged.

On the other hand, in Tosaki, the protective condition determining circuit and the wobble presence determining circuit are provided in parallel, where contents reproduction is restricted always based on determination results of both of the circuits. Tosaki does not however suggest, expressed or implied, the above-mentioned significant claimed structural arrangements or features in which wobble determination is omitted for a recording medium that does not need protection; thereby, accelerating reproduction processing.

In view of the above, the applicants submit that not all of the claimed elements or features of the applicants' claimed invention, as now recited in the amended claims filed herewith, are found in exactly the same situation and united in the same way to perform the identical function in Tosaki's device or process. Thus, there can be no anticipation under 35 U.S.C. §102(b) of the applicants' claimed invention, as now set forth in the amended claims filed herewith, based on the teachings of Tosaki.

In view of the above, the withdrawal of the outstanding anticipation rejection under 35 U.S.C. §102(b) based on Tosaki (EP 1 067 544 A1) is in order, and is therefore respectfully solicited.

Furthermore, even if *arguendo* the teachings of Tosaki and the AAPA can be combined in the manner suggested by the Examiner, such combined teachings of the cited prior art would still fall far short in fully meeting the applicants' claimed invention, as now recited in the amended claims filed herewith. As such, a person of ordinary skill in the art would not have found the applicants' claimed invention, as now set forth in the amended claims, obvious under 35 U.S.C. §103(a) based on Tosaki and the AAPA, singly or in combination.

In view of the above, the withdrawal of the outstanding obviousness rejection under 35 U.S.C. §103(a) based on Tosaki in view of AAPA is in order, and is therefore respectfully solicited.

In view of the aforementioned amendments and accompanying remarks, claims, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicants' undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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